

ESTTA Tracking number: **ESTTA709926**

Filing date: **11/20/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92062532
Party	Defendant Kretek International, Inc.
Correspondence Address	KRETEK INTERNATIONAL INC 5449 ENDEAVOUR COURT MOORPARK, CA 93021-1712 UNITED STATES trademarks@kretek.com
Submission	Answer and Counterclaim
Filer's Name	Joel R. Feldman, Esq.
Filer's e-mail	atltrademark@gtlaw.com, feldmanjoel@gtlaw.com
Signature	/jrf/
Date	11/20/2015
Attachments	Cancellation92062532.pdf(175394 bytes)

Registration Subject to the filing

Registration No	3796036	Registration date	06/01/2010
Registrant	GHSC TRADING B.V. KEIENBERGWEG 51,1101 GA AMSTERDAM, NETHERLANDS		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 009. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Prerecorded DVDs featuring information about cannabis
Class 014. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Key chains and key rings of precious metal, watches, jewelry
Class 021. First Use: 2006/07/31 First Use In Commerce: 2006/07/31 All goods and services in the class are requested, namely: Cups, saucers, drinking glasses, plates, coffee stirrers and stirrers for otherdrinks, drip mats for tea, bottle-openers

)	
GHSC TRADING B.V.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92062532
)	
KRETEK INTERNATIONAL,)	
)	
Registrant.)	
)	

Registrant Kretek International (“Kretek”), by and through its undersigned counsel, responds to Petitioner GHSC Trading B.V.’s Petition for Cancellation as follows:

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11. Kretek denies the allegations of Paragraph 11.
12. Kretek denies the allegations of Paragraph 12.
13. Kretek denies the allegations of Paragraph 13.
14. Kretek denies the allegations of Paragraph 14.
15. Kretek denies the allegations of Paragraph 15.

FIRST AFFIRMATIVE DEFENSE

Petitioner has failed to state a dilution claim upon which relief can be granted. Even if the allegations in Petitioner's Petition for Cancellation are true, the Petition for Cancellation does not contain a proper pleading of the claim of dilution under Lanham Act Section 43(c).

SECOND AFFIRMATIVE DEFENSE

Petitioner has failed to state a fraud claim upon which relief can be granted. Even if the allegations in Petitioner's Petition for Cancellation are true, the Petition for Cancellation does not contain a proper pleading of the claim of fraud under *Torres v. Cantine Torresella S.r.l.*

THIRD AFFIRMATIVE DEFENSE

Petitioner does not have standing to assert a claim based on U.S. Application Serial No. 86328179. Celodast A.G.'s assignment of U.S. Application Serial No. 86328179 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

FOURTH AFFIRMATIVE DEFENSE

Petitioner does not have standing to assert a claim based on U.S. Application Serial No. 86328200. Celodast A.G.'s assignment of U.S. Application Serial No. 86328200 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

FIFTH AFFIRMATIVE DEFENSE

Petitioner does not have standing to assert a claim based on U.S. Application Serial No. 86328217. Celodast A.G.'s assignment of U.S. Application Serial No. 86328217 before the filing of a statement of use violated the anti-assignment provision of Trademark Act § 10.

SIXTH AFFIRMATIVE DEFENSE

Petitioner's claims are barred by the doctrine of estoppel. During the prosecution of U.S. Application Serial No. 77219071, which matured into U.S. Reg. No. 3796036, Petitioner's predecessors in interest, Brenda Helena Frantzen and Arjan Roskam, induced the Trademark Office to approve their application by making the following statements: (i) "Applicants' Mark is highly stylized and includes a design element in the form of leaves growing on vines"; (ii) "Applicants' Mark is also yellow and black, which provides greater emphasis to the organic nature of the mark"; (iii) "Applicants' Mark also contains an additional word element – 'SEED.' This word element further distinguishes the two marks since it provides a different connotation to the mark"; (iv) "[T]rademarks containing 'GREEN HOUSE' or 'GREENHOUSE' as an element are not uncommon in the United States"; and (v) "Applicants' Mark is used solely in conjunction with their own products. Applicants' customers are familiar with applicants' products . . ." In support of their application, Ms. Frantzen and Mr. Roskam attached numerous printouts from the USPTO Trademark Database, including U.S. Reg. No. 2,737,014 for GREENHOUSE in International Class 34 for cigars, cigarettes, cigarillos, ashtrays not of precious metal, cigar cutters, cigarette cases not of precious metal, cigarette holders not of precious metal, cigarette lighters not of precious metal, pipes for smoking, pipe cleaners for smoking, matches, tobacco pouches, cigarette rolling papers and tobacco. U.S. Reg. No. 2,737,014 was owned by Kretek Distributors, Incorporated d/b/a Kretek Imports, Inc., a

predecessor in interest to Kretek, and was valid and subsisting at the time Ms. Frantzen and Mr. Roskam sought registration of U.S. Application Serial No. 77219071. Based on the prosecution history of U.S. Application Serial No. 77219071, Petitioner is estopped from arguing that Kretek's application to register GREENHOUSE in International Class 34 for the applied-for goods will cause a likelihood of confusion with U.S. Reg. No. 3796036.

SEVENTH AFFIRMATIVE DEFENSE

Petitioner's claims are barred by the doctrine of estoppel. During the prosecution of U.S. Application Serial No. 77219071, which matured into U.S. Reg. No. 3796036, Petitioner's predecessors in interest, Brenda Helena Frantzen and Arjan Roskam, induced the Trademark Office to approve their application by disclaiming the wording "GREEN HOUSE SEED CO." with respect to the registration of "GREEN HOUSE SEED CO. & Design" in International Class 9 for prerecorded DVDs featuring information about cannabis.

COUNTERCLAIM FOR CANCELLATION OF PETITIONER'S U.S. TRADEMARK REG. NO. 3,796,036

1. According to the USPTO's records, Petitioner owns, by assignment, U.S. Trademark Reg. No. 3,796,036 for mark shown below (the "Stylized GHSC Mark") in (i) International Class 9 for prerecorded DVDs featuring information about cannabis (the "Class 9 Goods"), (ii) International Class 14 for key chains and key rings of precious metal, watches, jewelry (collectively, the "Class 14 Goods"), and (iii) International 21 for cups, saucers, drinking glasses, plates, coffee stirrers and stirrers for other-drinks, drip mats for tea, bottle openers (collectively, the "Class 21 Goods"):



2. U.S. Trademark Reg. No. 3,796,036 issued on June 1, 2010.

COUNT I
ABANDONMENT

3. Petitioner has taken the position before the Trademark Trial and Appeal Board that “GREENHOUSE” and the Stylized GHSC Mark are similar in sight, sound, meaning, and overall commercial impression.

4. Kretek conducted an investigation, reasonable in scope, regarding Petitioner’s past and current use of the Stylized GHSC Mark.

5. Upon information and belief, Petitioner is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods.

6. Upon information and belief, Petitioner has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods for at least three years.

7. Upon information and belief, Petitioner has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 9 Goods.

8. Upon information and belief, Petitioner is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods.

9. Upon information and belief, Petitioner has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods for at least three years.

10. Upon information and belief, Petitioner has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 14 Goods.

11. Upon information and belief, Petitioner is not currently using the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods.

12. Upon information and belief, Petitioner has not used the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods for at least three years.

13. Upon information and belief, Petitioner has no *bona fide* intention to resume using the Stylized GHSC Mark in the United States in interstate commerce for the Class 21 Goods.

14. Petitioner has abandoned U.S. Trademark Reg. No. 3,796,036, and this registration should be canceled by the Trademark Trial and Appeal Board.

WHEREFORE, Kretek requests that (1) the instant cancellation action be dismissed, (2) the counterclaim for cancellation be sustained, (3) Petitioner's pleaded registration be canceled, and (4) Petitioner's pleaded applications be declared void.

Date: November 20, 2015

Respectfully submitted,
GREENBERG TRAURIG, LLP



By: _____

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**Attorneys for Registrant
Kretek International**

CERTIFICATE OF ELECTRONIC TRANSMISSION

Date: November 20, 2015

I certify that this Answer and Counterclaim is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, on the date indicated above, through the ESTTA electronic filing system at the web site <http://estta.uspto.gov/>.



Joel R. Feldman, Esq.

CERTIFICATE OF SERVICE

I certify that on November 20, 2015, I served the foregoing Answer and Counterclaim by first-class mail to:

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